

WENZEL et al., Serial No. 09/782,306

REMARKS

Claims 1-13 are pending. Claims 1 and 2 have been amended. Claim 13 is new and finds support at page 2, lines 18-20 of the specification.

The Examiner objected to claims 1 and 2 because of informalities. In response, applicants herein amend claims 1 and 2.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

Claim 1 states that R<sup>7</sup> is a sugar substituent. Applicants have added a new claim 13 which further limits the definition of R<sup>7</sup>. Nonetheless applicants believe claim 1 is definite as it stands. While the term "sugar substituent" may be broad, breadth of a claim is not to be equated with indefiniteness. MPEP 2173.04; *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). One having ordinary skill in the art would have been able to ascertain the metes and bounds of this limitation with a reasonable degree of particularity and distinctness based on the guidance given in the specification, as for example in Tables 1-4.

In claim 3, it appears that the Examiner would like the applicants to specify the therapeutic conditions to remove the indefiniteness rejection. In response, applicants believe the Examiner again equates breadth of a claim with indefiniteness. A "therapeutically effective amount of a compound of claim 1" may vary from condition to condition, but this does not mean that the amount to be administered cannot be defined. In *Ex parte Skuballa* 12 USPQ2d 1570 (BPAI 1989), the Board held that such language was definite, particularly when read in light of the supporting disclosure. MPEP 2173.05(c)III.

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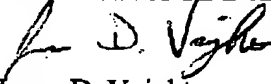
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Respectfully submitted,  
NOVAK DRUCE DeLUCA & QUIGG LLP

  
Jason D. Voight  
Reg. No. 42,205

Customer No. 26474  
1300 Eye Street, N.W.  
Suite 400 East  
Washington, D.C. 20005  
(202) 659-0100